REMARKS

This responds to the Office Action dated April 13, 2006, and the references cited therewith.

Claim 5, 10 and 21 are amended, claims 11, 29 and 36 are canceled; as a result, claims 1-10, 12-28, and 30-35 are now pending in this application.

§112 Rejection of the Claims

Claim 5 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is amended to have "the IDS table" replaced by "an IDS table". Therefore, Applicants believe that the rejection to claim 5 is no longer appropriate and should be withdrawn.

§102 Rejection of the Claims

Claims 1-29 and 31-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Grainger et al. (U.S. Publication No. 2002/0065677A1). To sustain an anticipation rejection, each and every element or step in the rejected claims must be taught or suggested in the cited reference.

Independent claim 1 claims: "A system for managing information disclosure statement (IDS) references, comprising: a computing system; a first software component operable on the computing system to generate a plurality of IDS forms; and **a second software component operable on the computing system to manage IDS references for at least one organization; wherein each organization only has access to its own IDS references.**"

The Examiner indicates that Grainger teaches such feature of claim 1, "each organization only has access to its own IDS references". The Applicants assert that Grainger patent does not teach the feature "each organization only has access to its own IDS references".

See paragraph 0080 of the Grainger publication, which states the following: "Additionally, each client system would be able to access all of the electronic IDS stored in database 804. This embodiment is particularly suited for applications where multiple users will be generating and accessing the same electronic IDS for a single pending or future patent application." And see paragraph 0081, "the access to each electric IDS may be limited to individuals falling under the duty of disclosure for the corresponding future or pending patent application."

Thus, according to Grainger, individuals may have access to IDS references which are not their own, as long as they are falling under the duty of disclosure for the corresponding future or pending patent application. Therefore, Grainger teaches away from the feature "each organization only has access to its own IDS references" which is positively recited in claim 1.

Furthermore, the examiner fails to mention whether/where Grainger teaches or suggests "a second software component operable on the computing system to manage IDS references for at least one organization". In fact, Grainger does not teach or suggest "**a second software component operable on the computing system to manage IDS references for at least one organization**" as claimed in claim 1.

Thus, Applicants submit Grainger cannot be said to anticipate Applicants' claim 1 and respectfully request that the rejection with respect to claim 1 should be withdrawn.

With respect to claim 2, it depends on claim 1. Claim 2 positively recites that the system further comprises "*third software component operable on the computing system to provide a presentation for managing the IDS references associated with each matter of the at least one organization*". However, Figs. 13A-20 of Grainger does not indicate the existence of the third software component "for managing the IDS references associated with each matter of the at least one organization." Thus, claim 2 cannot be said to be anticipated by Grainger.

With respect to claim 3, it depends on claim 2. Claim 3 further comprises: "*a fourth software component operable on the computing system to manage matters for the at least one organization; wherein the second software component is a part of the fourth software component.*" The examiner implies that Fig. 13A shows "Prior Art associates with Case". In fact, the feature "Prior Art associates with Case" of Grainger teaches away from the feature of claim 3, since Grainger manages all the prior arts which are associated with each particular case, while the system of claim 3 manages all the cases (matters) for each particular organization. Thus, Grainger teaches away from claim 3. Thus, claim 3 is not anticipated by Grainger.

With respect to claim 4, it depends on claim 3. Furthermore, claim 4 positively discloses that the system further comprises: "*a fifth software component operable on the computing system to manage activities within matters; a sixth software component operable on the computing system to manage organizations; a seventh software component operable on the computing system to manage tasks within matters; an eighth software component operable on the computing system to provide communications; and a ninth software component operable on the computing system to provide security; wherein the third, fourth, fifth, sixth, seventh, eighth. and ninth software components are capable of interfacing with the first and second software components in a patent prosecution enterprise application*".

However, the examiner fails to point out which parts of Figs. 13A-20 of Grainger show correspondingly the existence of fifth, sixth, seventh, eighth, and ninth software components for performing the relevant operations. Thus, all of these shows that claim 4 is not anticipated by Grainger.

With respect to claim 5, it depends on claim 1. Furthermore, claim 5 positively disclose that the system further comprises: "an IDS holder; an IDS patents holder related to the IDS holder; an IDS publications holder related to an IDS table; and an IDS source holder to indicate how to access the stream of data associated with each IDS reference." However, Figs. 13A-20 of Grainger does not show correspondingly the existence of IDS holder, IDS patents, IDS publications holder, and IDS source holder. Thus, all of these shows that claim 5 is not anticipated by Grainger.

With respect to claims 6-9, they depend directly or indirectly on claim 5, accordingly, for the reasons discussed for claim 5, claims 6-9 are not anticipated by Grainger.

Claim 10 claims:

"A method for IDS reporting, comprising:

receiving a report specification;

interpreting the report specification;

generating an answer file;

receiving a plurality of transformations to act on the answer file and an IDS form definition file; and

providing an IDS report."

Grainger mentions extracting IDS information from electronic documents into IDS in paragraphs 0038-0039. However, Grainger does not teach or suggest the steps "generating an answer file" and "receiving a plurality of transformations to act on the answer file and an IDS form definition file", which are positively recited in claim 10. Thus, Applicants respectfully submit that claims 10 is not anticipated by Grainger.

Claim 11 is canceled.

With respect to claim 12, it depends on claim 10, accordingly, for the reasons discussed for claim 10, claim 12 is not anticipated by Grainger.

Claim 13 claims: "*A method for managing information disclosure statement (IDS) references, comprising: receiving a request to add an new information disclosure statement (IDS) reference to a first matter; searching for all matters related to the first matter; and adding the new IDS reference to selected matters related to the first matter.*"

The examiner implies that Fig. 5 of Grainger discloses claim 13 of the present application. Fig. 5 of Grainger is a flowchart illustrating the generation of an IDS. However, Fig. 5 of Grainger does not teach or suggest the steps "searching all matters related to the first matter" and "adding the new IDS reference to selected matters related to the first matter" as recited positively in claim 13. In fact, Fig. 5 of Grainger does not teach or suggest adding Information Disclosure Statement(s) of a case to all the cases related to that case. Thus, Applicants respectfully submit the rejection with respect to claim 13 should be withdrawn.

With respect to claim 14-16, they directly or indirectly depend on claim 13, accordingly, for the reasons discussed for claim 13, claim 14-16 are not anticipated by Grainger.

Claim 17 claims: "A system for managing information disclosure statement (IDS) references, comprising: a computing system; a presentation layer operable on the computing system to present an information disclosure statement (IDS) reference inventory system; a business logic layer operable on the computing system to manage the IDS reference inventory system and to generate IDS forms; and a data layer operable on the computing system to manage the data associated with the IDS reference inventory system."

The examiner implies that Fig. 11 of Grainger discloses claim 17 of the present application. Fig. 5 of Grainger is a block diagram illustrating the relationship between an IP data processing system 1100 and participants in the patent process, like technology developers, patent law firms, patent offices, prior art databases, and potential licensees. However, FIG. 11 of Grainger does not include the business logic layer which is recited in claim 17. Thus, Applicants submit Grainger cannot be said to anticipate claim 17 and respectfully request that the rejection with respect to claim 17 should be withdrawn.

With respect to claim 18-20, they directly depend on claim 17, accordingly, for the reasons discussed for claim 17, they are not anticipated by Grainger.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 10/087,561
Filing Date: March 1, 2002
Title: SYSTEMS AND METHODS FOR MANAGING INFORMATION DISCLOSURE STATEMENT (IDS) REFERENCES

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Dkt: 1551.002US1

Currently, claim 21 claims: *"A computer-readable medium storing computer-executable instructions for performing a method, the method comprising: providing a presentation capable of associating at least one information disclosure statements (IDS) reference to at least one matter; providing a presentation capable of listing each IDS reference associated with each matter; and restricting access to IDS references so that each organization only has access to its own IDS references. "* Grainger dos not teach or suggest that each organization only has access to its own IDS references. This limitation is positively recited in currently amended claim 21. Thus, Applicants submit Grainger cannot be said to anticipate Applicants' claim 21 and respectfully request that the rejection with respect to claim 21 should be withdrawn.

With respect to claims 22-28 and 31-35, they depend directly or indirectly on claim 21, accordingly, for the reasons discussed for claim 21, they are not anticipated by Grainger.

Claim 36 is canceled.

§*103 Rejection of the Claims*

Claim 30 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grainger et al. (U.S. Publication No. 2002/0065677A1), in view of Official Notice.

According to M.P.E.P. 2144.03 A. "Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR **1.113**. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known."

The Applicant respectfully request the examiner for the documentary evidence to support the examiner's conclusion.

Furthermore, to retain a rejection to a claim under §103(a), the prior art reference (or references when combined) must teach or suggest all the claim limitations, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The examiner acknowledges that Grainger fails to teach "providing an accounting system to track costs associated with storing IDS references" which is recited in claim 30.

And claim 30 is dependent from claim 21. Accordingly, claim 30 includes the feature "restricting access to IDS references so that each organization only has access to its own IDS references", which are currently added to claim 21. This feature is not disclosed in Grainger.

See paragraph 0080 of the Grainger publication, which states the following: "Additionally, each client system would be able to access all of the electronic IDS stored in database 804. This embodiment is particularly suited for applications where multiple users will be generating and accessing the same electronic IDS for a single pending or future patent application." And see paragraph 0081, "the access to each electric IDS may be limited to individuals falling under the duty of disclosure for the corresponding future or pending patent application." Thus, according to Grainger, individuals may have access to IDS references which are not their own, as long as they are falling under the duty of disclosure for the corresponding future or pending patent application. Therefore, Grainger teaches away from the feature "each organization only has access to its own IDS references" as claimed in claim 30.

Thus, Grainger does not teach or suggest all the limitations which are recited in claim 30, and certainly does not suggest to combine reference teachings. Accordingly, Applicants submit that claim 30 is not rendered obvious over Grainger in view of Official Notice, and respectfully request that the rejection with respect to claim 30 should be withdrawn.
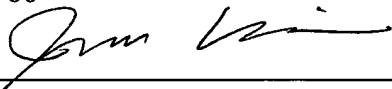
CONCLUSION

Applicant respectfully submits that claims 1-10, 12-28, and 29-35 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6966 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this __11__ day of June, 2006.

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